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OFFICE OF PETITIONS

In re Patent No. 6,908,656 :
Issued: June 21, 2005 :
Application No. 09/783,354 : PATENT TERM ADJUSTMENT
Filed: February 14, 2001 :
Atty. Dkt. No.: IRC293-14060/205649 :
:

This is a decision on the "Letter in Response to Patent Term Adjustment Letter..." submitted July 22, 2005. This matter is being treated as an application for patent term adjustment under 37 CFR 1.705(d).

The application for patent term adjustment ("PTA") under 37 C.F.R. § 1.705(d) is **DISMISSED**.

The above-identified application matured into U.S. Patent No. 6,908,656 on June 21, 2005. Applicants submitted an application for patent term adjustment (PTA) under 37 CFR 1.705(b) on October 15, 2004 and argued that in accordance with 37 CFR 1.702(b), the then pending application was entitled to an increase in adjustment because the application was slated to issue more than three years beyond the date upon which the application was filed. The decision mailed March 30, 2005 advised that a decision regarding the request for additional adjustment under 37 CFR 1.702(b) would be held in abeyance pending issuance of the patent. The decision further advised applicants to submit a letter within two months of the issuance of the patent if at the time of issuance the appropriate adjustment under 37 CFR 1.702(b) had not been accorded.

Applicants have submitted the instant application for PTA under grounds set forth at 37 CFR 1.704(c)(10), not 37 CFR 1.702(b). Accordingly, petitioners' attention is directed to the provisions of 37 CFR 1.705(d) wherein it states:

If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues.

Applicants are further advised that the provisions of 37 CFR 1.705(b)(1) require applicants to submit the required application fee of \$200.00 for any application for patent term adjustment pursuant to 37 CFR 1.705(d).

Applicants herein have failed to submit the required application fee. Accordingly, the instant application for PTA for grounds raised under 37 CFR 1.704(c)(10) is hereby DISMISSED.

Moreover, assuming arguendo that applicants had properly complied with the provisions of 37 CFR 1.705(b)(1) and 1.705(d) and submitted the instant application for adjustment for grounds raised under 37 CFR 1.704(c)(10), the application for adjustment would nonetheless be subject to dismissal.

Applicants submitted a miscellaneous paper on October 13, 2004. Accordingly, a reduction of 120 days was accorded under 37 CFR 1.704(c)(10).


Applicants argue that the miscellaneous paper submitted October 13, 2004 was necessitated by the fact that the PTO prior to the issuance of the Notice of Allowance failed to initial applicants PTO/SB08a which had been submitted September 15, 2003.

Petitioners' argument is deemed without merit. Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed is deemed a failure to engage in reasonable efforts to conclude prosecution (or processing). This is certainly the case herein whereby prior to the issuance of the Notice of Allowance, applicants could have requested review of the PTO/SB08a. Specifically, a supplemental non-final Office action was mailed June 2, 2004. Applicants' response to the supplemental non-final Office action submitted July 12, 2004 did not request action on the PTO/SB08a form. Thus, the request submitted October 13, 2004 could have been made prior to the issuance of the Notice of Allowance. As a result, submission of the request after such as time as the Notice of Allowance was mailed is deemed a failure to engage in reasonable efforts to conclude prosecution (or processing).

Thus, the PTA, as correctly indicated on the patent, is 157 days.

Any request for reconsideration of this decision must be submitted within 30 days of the mail date of this decision. This period of time for response cannot be extended under 37 CFR 1.136.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.


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